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FINNEGAN HENDERSON FARABOW
GARRETT & DUNNER
1300 I STREET NW
WASHINGTON DC 20005

EXAMINER

LIOTT, C

ART UNIT

PAPER NUMBER

1751

8

DATE MAILED: 10/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action SummaryApplication No.
09/319,204Applicant(s)
De La Mettrie et al.Examiner
Caroline D. LiottGroup Art Unit
1751☒ Responsive to communication(s) filed on Aug 15, 2000☒ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims☒ Claim(s) 32-74 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.☒ Claim(s) 32-74 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claims _____ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.☐ received in Application No. (Series Code/Serial Number) _____.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Amendments filed 8/15/00 have been entered. Applicant's Remarks filed 8/15/00 have been fully considered.

If bracketing is intended to appear in the claims of the published patent of the instant application (see e.g. claim 66), bracketing and underlining should not be used to indicate any future amendments or changes to the claims in order to avoid confusion during printing. See 37 CFR 1.121(a)(2)(ii).

Claim Rejections

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 32-64, 66-68 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamahatsū, EP 716,846. This rejection is maintained for the reasons set forth in the previous Office Action, Paper #6 mailed 5/9/00.

Claims 32-64, 66-68 and 73-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamahatsu as applied to claims 32-64, 66-68 and 74 above, and further in view of Husemeyer, U.S. Patent No. 4,840,639. This rejection is maintained for the reasons set forth in the previous Office Action, Paper #6 mailed 5/9/00.

Claims 32-72 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotteret, U.S. Patent No. 5,514,188, in view of Tsujino, U.S. Patent No. 4,961,925. This rejection is maintained for the reasons set forth in the previous Office Action, Paper #6 mailed 5/9/00.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 32-74 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25-65 of copending Application No. 09/319,165. This provisional rejection is maintained for the reasons set forth in the previous Office Action, Paper #6 mailed 5/9/00. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application recite ready-to-use hair dyeing compositions which contain 1) at least one first oxidation base chosen p-phenylenediamines as instantly claimed; 2) at least one second oxidation base chosen from p-aminophenols as instantly claimed; 3) at least one m-aminophenol coupler chosen from 2-methyl-5-N-(beta-hydroxyethyl)aminophenol and acid addition salts thereof as instantly claimed; 4) at one 2-electron oxidoreductase enzyme; and 5) at least one donor as instantly claimed. The copending claims also recite corresponding hair dyeing processes and multi-compartment dyeing kits as instantly claimed. Therefore, the copending claims obviate the instantly claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments and Amendments

Applicant's Amendments have overcome the claim objections and 35 U.S.C. 112, second paragraph, rejections previously of record.

Applicant's Remarks regarding the 35 U.S.C. 103(a) rejection over Yamahatsu have been fully considered, but are not deemed persuasive to overcome the rejection of record for the

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following reasons. Applicant argues that Yamahatsu's list of oxidation dyes does not necessarily teach an equivalence, and one would still have to pick and choose from among those listed to arrive at the claims. These arguments are not deemed persuasive because Yamahatsu's teaching that each listed dye is an appropriate oxidation dye for use in the patentee's compositions suggests their equivalence. The only "choosing" required by those skilled in the art is to at least partially replace p-phenylenediamine with a PPD derivative as claimed, e.g. with p-toluenediamine in order to obtain a different color. Because these compounds are structurally similar and taught as being used for the same purpose, i.e. oxidation dyes, those skilled in the art would have had the proper motivation to perform the relied upon substitution. Furthermore, substitution of equivalents requires no express motivation as long as the prior art recognizes the equivalency. See *In re Fount*, 213 USPQ 532 (CCPA 1982).

Applicant argues that because each of Yamahatsu's exemplified compositions contains p-phenylenediamine, the patentee teaches away from using a p-phenylenediamine derivative as claimed. A reference is never limited to its working examples when applied under 35 U.S.C. 103(a). Yamahatsu never requires the presence of p-phenylenediamine, and teaches that the oxidation dyes which may be used are not limited. For these reasons, the 35 U.S.C. 103(a) rejection over Yamahatsu remains.

Applicant's Remarks regarding the 35 U.S.C. 103(a) rejection over Yamahatsu in view of Husemeyer have been fully considered, but are not deemed persuasive to overcome the rejection of record for the following reasons. Applicant argues that Husemeyer fails to recite a

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compositions which contains two oxidations, let alone a combination as claimed, and also does not teach the claimed enzymes and donors. First, as noted in the rejection Husemeyer teaches that additional oxidation bases may be used with those of the patentee. Second, Husemeyer should not be attacked individually when used in combination. The patentee is not relied upon as teaching the claimed dye mixtures alone, nor the claimed oxidants.

Applicant argues that Yamahatsu's teaching of uricase stability is not concerned with the overall stability of the compositions or the dyes therein. Examiner respectfully disagrees because those skilled in the art would recognize that Yamahatsu's teaching of uricase stability suggests that stability of the entire composition is desirable. Furthermore, Husemeyer provides many beneficial reasons to use the claimed oxidation base in Yamahatsu's compositions.

Applicant argues that Husemeyer's teachings of improved results are given too much weight because there is no evidence proving such improved results, and such results cannot be extended to enzyme-containing compositions. The Office holds the position that Husemeyer's teachings are accepted to be valid and true, absent a showing otherwise. Applicant has interpreted Husemeyer's example as being prophetic with a possible, not actual, result. Examiner respectfully disagrees with this interpretation of Husemeyer. Furthermore, because Yamahatsu teaches that the oxidation dyes which may be used are not limited, those skilled in the art would expect that Husemeyer's oxidation bases could successfully be used in Yamahatsu's compositions. For all these reasons, the rejection over Yamahatsu in view of Husemeyer remains.

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Applicant's Remarks regarding the 35 U.S.C. 103(a) rejection over Cotteret in view of Tsujino have been fully considered, but are not deemed persuasive to overcome the rejection of record for the following reasons. Applicant argues that Cotteret is deficient because no oxidant as claimed is disclosed. Applicant argues that Tsujino provides no specific teaching of a combination of ingredients as claimed. Applicant therefore concludes that the references are not combinable. Examiner does not follow this rationale, and as argued above, notes that the references should not be attacked individually when cited under 35 U.S.C. 103(a) in combination. Examiner notes that a reference applied under 35 U.S.C. 103(a) need not teach every element of the claimed invention when combined with a secondary reference which provides teachings of the missing claimed elements.

Applicant argues that the Office has failed to present "clear and particular" evidence that the teachings of Cotteret and Tsujino should be combined. Applicant supports this argument by pointing to Tsujino's examples 1-12 and 1-13 wherein Tsujino's enzymatic dyeing systems result in "almost the same" dyeing effect as hydrogen peroxide. Applicant therefore concludes that those skilled in the art would not expect an improvement when substituting the oxidants of Cotteret with those of Tsujino. The Office respectfully disagrees because although those skilled in the art would expect equivalent dyeing upon making such a substitution, an improvement in the hair texture and skin sensitivity would be expected. Because Tsujino teaches decreased damage to the skin and hair, those skilled in the art would have proper motivation to perform the substitution expecting these improved results.

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Applicant argues that Cotteret is not concerned with finding a mild oxidant, and Tsujino is not concerned with the selection of oxidation dye combinations. Cotteret need not suggest the need for a milder oxidant to obviate the claimed invention when Tsujino provides sufficient motivation to substitute Cotteret's oxidant. Those skilled in the art would recognize that the teachings of Cotteret and Tsujino are combinable because they both teach oxidative hair dye compositions. Tsujino is not relied upon as teaching the claimed dye and coupler combinations. Tsujino does, however, teach that the patentee's oxidants are suitable for use with many of the developers and couplers which may be present in Cotteret's compositions. For all these reasons, the 35 U.S.C. 103(a) rejection over Cotteret in view of Tsujino remains.

Examiner notes Applicant's Remarks regarding the provisional obviousness-type double patenting rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caroline Liott whose telephone number is (703) 305-3703. The examiner can normally be reached on Mondays-Thursdays from 8:30am to 6:00pm, and on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached at (703)308-4708. All before final official faxes should be sent to (703) 305-7718. All after final official faxes should be sent to (703) 305-3599. All non-official faxes should be sent to (703) 305-6078.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0661.

C.D.L.
October 23, 2000


CAROLINE D. LIOTT
PRIMARY EXAMINER